REMARKS

Claims 1-46 are pending in the present case. No claim is allowed.

Information Disclosure Statement

The Office Action notes that the PTO-1449 form and attached art for the IDS dated February 1, 2001 are missing from the file wrapper. Submitted herewith are a copy of the corresponding PTO-1449 form and the one piece on non-US patent art for consideration.

The 35 U.S.C. § 103 Rejection

According to M.P.E.P. § 2143,

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

Claims 1, 2, 4-15, 17-28, 30-38, 40-43, 45, and 46 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hogan et al.* in view of *Lindholm*. Claim 44 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hogan et al.* in view of *Lindholm* in further view of *Nakagawa et al..* Claims 3, 16, 29, and 39 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hogan et al.* in view of *Lindholm* in further view of *Gish.* These rejections are respectfully traversed.

Specifically, the Office Action states that *Hogan* discloses or suggests most of the claim limitations and that *Lindholm, Nakagawa,* and *Gish* disclose or suggest the remaining claim limitations. However, each and every element as set forth in the present claims are not found in or suggested by the cited prior art. Furthermore, the various combinations of elements proposed by the Office Action are never arranged by the cited prior art in the same manner as proposed by the Office Action or as required by the present claims. The laundry list of citations are often incorrect or inconsistent with one another.

2

Hogan discloses a Real-Time Embedded Software repository system. "Real-Time Embedded Software (RTES) is software that executes on customer hardware boards that are found within end-user products such as cellular phones, ATM switches, and anti-lock brake systems." (Column 1, lines 15-18) The Repository System involves a number of devices including a "Repository Server...[which] is a computer with a program based on web server technology which contains a Repository file system that allows storing, searching, and retrieving of Repository Units." (Column 8, lines 11-14) *Hogan* defines a Repository Unit as "...the smallest piece of information relating to embedded software stored in the MXP Repository." (Column 7, lines 28-29)

It is important to note that the Repository Units are merely "stored" in the repository file system and are not "embedded" into the repository operating system or into an embedded processor. According to the definition, the Repository Units "relate" to embedded software. Thus, it would be more accurate to describe the Repository Units as being "embeddable" rather than actually being embedded. Further, the Repository Units are not executed by the Repository System but by the "customer hardware boards." Further still, the execution of the Repository Units does not effect, including configuring or managing, the Repository System but does effect the "end-user product" whatever that might be. The Repository System is like a RTES software warehouse or catalog. The Repository System aids in the creation of embedded devices, it is not an embedded device itself. The Repository Units are not assembled into any program but are made visible for software engineers to re-use. The average consumer would not go to the store to buy a Repository System.

It is also important to note that *Hogan* does not rely on the specific function of any of the Repository Units. This is because the Repository System never executes or contains the Repository Units as part of its operating system. Providing a demonstration is not the same function. For example, if one were a shoe sales person then to take a shoe out of a box and show it to a potential customer and let them try it on is not the same as owning and wearing the shoe yourself. The Repository System will organize whatever Repository Units it has available to

3

provide visibility to those Repository Units. The Repository System does not prescribe the Repository Unit and its components. The Repository System does not care whether the Repository Unit is new or old. If either version might be of use, then it will store them both.

With this background, the details of the rejection regarding claims 1, 13, and 27 will be examined as an example. The following citations by the Office Action are to *Hogan*.

First, the Office Action cites "obtaining a network device control software program from a network device such as a web server(s) system (Fig. 2, A, B, C)" Since Server A 7, Server B 10, and Server C 12 are not software programs themselves, it is assumed that the citation is to the corresponding operating system for those items. *Hogan* describes "[t]he Repository Servers 7, 10, and 12 [as] multi-user servers that provide access to reusable software to an internetworked user community. The Repository Servers 7, 10, and 12 are accessed by Repository Clients 8 and 9 and Repository Station 11. The Repository Clients 8 and 9 and Repository Station 11 access the appropriate Repository databases where the Repository Units meeting the requirements of a particular search reside." (Column 10, lines 58-65) It is important to note that the Repository Server operating system and the Repository Units are separate and distinct. One is not embedded into the other and one is not used to control the operation of the other.

The Office Action next cites "obtaining a downloadable unit (col 7/lines 28-34) configured to communicate with the network device control software program for later transmission over a network to a remote client to enable the remote client to remotely configure the network device (col 15/line 37-col 16/line 67)." The first citation equates the downloadable unit with the Repository Unit which as noted above is distinct from the Repository Server operating system. The second citation equates "managing a local Repository" (Column 15, line 40) or "interact[ing] with the Repository Server" (Column 16, line 10) with configuring the network device. The former involves a different network device from the citation above, that is, Repository rather than Repository Server. This is inconsistent. The latter involves interacting rather than configuring as claimed. These actions are not the same. To the contrary, *Hogan* discloses that the "[u]sers access the Repository Servers using Repository Client software" and

4

not by using the Repository Units or the Repository Server operating system. (Column 16, lines 7-8) This is not as claimed and is inconsistent with the citation above.

The Office Action next cites "the downloadable unit including a communicator component...(col 21/lines 1-10), an interface component...(col 8/lines 15-18, col 5/lines 12-20, col 16/line 6-39, col 6/lines 43-44), and a configuration component...(col 16/lines 37-63, col 5/lines 12-15)." The first citation is to the "RTES Application Player Desktop utility" that is included on the "Repository Client (and Repository Station)". (Column 20, lines 63-64) The second citations include the "Repository Client", non-enabling objects of the invention, "Repository Server access software", and a non-enabling and vague one line summary. The third citations include the "Application Player" which is also included in the "Repository Client and Repository Station" (Column 16, lines 29-36) and a duplicate from above of one of the non-enabling objects of the invention. In every case, the citations are not to Repository Units which were previously equated with the downloadable unit claimed. Further, the citations are to devices and software other than the Repository Server and the Repository Server operating system which were equated above with the network device and the network device control software. This is not as claimed and is inconsistent.

The Office Action next cites "compiling the software program into a binary file (col 11/lines 32-33, col 16/lines 27-28)." While the citations are to compilers, the compilers are for the Repository Units and not the Repository Server operating system which was equated above with the network device control software as claimed. *Hogan* never discloses compiling the Repository Server operating system. This is not as claimed.

The Office Action next cites "embedding the downloadable unit into the binary file (col 7/lines 28-34) storable in network devices (Fig. 2, 7, 10, 11, 12))." The first citation is to the definition of Repository Unit and the second citation is to the Repository Servers. These are consistent with and reinforce the citations above. However, the Repository Units are not embedded in the Repository Server, they are stored in the Repository. Further, to be consistent with the above citations, the binary file is supposedly compiled from the Repository Server

operating system which is neither on the Repository nor embedded with the Repository Units. This is not as claimed.

The Office Action finally cites "loading the into [sic] binary file with the embedded downloadable unit onto the network device (col 7/lines 28-34)." The citation is again to the definition of Repository Unit. However, as above, *Hogan* never discloses embedding the Repository Unit into the binary file supposedly compiled from the Repository Server operating system and loading it onto the Repository Server. The citation is silent as to where the Repository Unit is loaded. This is not as claimed.

The same inaccuracies and inconsistencies are applied to all of the claims either by reference to the above rejection or by identical citations. The additional citation of any or all of *Lindholm*, *Nakagawa*, and *Gish* does not remove the above problems.

Given these differences, the cited prior art cannot be said to make the present invention obvious. In view of the above, it is respectfully asserted that the claims are now in condition for allowance.
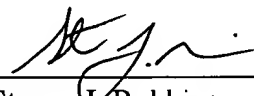
Request for Allowance

In view of the foregoing, reconsideration and an early allowance of this application are earnestly solicited.

If any matters remain which could be resolved in a telephone interview between the Examiner and the undersigned, the Examiner is invited to call the undersigned to expedite resolution of any such matters.

Respectfully submitted,
THELEN, REID, & PRIEST LLP

Dated: August 15, 2001

Steven J. Robbins
Reg. No. 40,299

Thelen, Reid, & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800